

### **REMARKS**

Claims 15 – 19 are pending in the application. Claims 1 – 14 have been cancelled. Claims 15 – 19 have been added. Support for the claims can be found throughout the specification, including, for example, page 17, lines 13 – 14, page 21, line 27 through page 22, line 8, page 29, lines 17 – 24, and FIG. 7. No new matter has been added.

#### **Information Disclosure Statement**

Attached is a copy of an Information Disclosure Statement that Applicants submitted with the Application on October 2, 1998. Applicants request that the Examiner ensure that he has considered all the references disclosed therein, and that Examiner initial the IDS and return a copy with the next action in this matter.

Also, Applicants wish to ensure that the Examiner aware of the Supplemental Information Disclosure Statement that was filed concurrently with this Response. Therefore, Applicants request that Examiner ensure that he has obtained the supplemental IDS and returns an initialed copy of IDS to the Applicants.

#### **Double Patenting Rejections**

Claims 1 – 12 were rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1 – 7 of U.S. Patent No. 6,667,969 and over claims 1 – 6 of U.S. Patent No. 5,869,254. Claims 1 – 12 have been cancelled. If the Examiner is of the opinion that the double patenting rejection will apply to new claims 15 – 19, Applicants request Examiner to contact Applicants' representative so the appropriate Terminal Disclaimer can be presented.

#### Rejections under 35 U.S.C. §112, first paragraph

Claims 1 – 4 and 6 – 12 were rejected under 35 U.S.C. § 112, first paragraph, because, according to the Examiner, the specification was not enabling the use of ribozymes *in vivo* in whole organisms. While applicants do not concede the merits of this rejection, they thank the Examiner for recognizing that the specification does enable making and using the ribozymes *in vitro* or in cell culture. New independent claim 15 is directed to a method in cell culture. Accordingly, Applicants request that the rejection under 35 U.S.C. § 112, first paragraph, be withdrawn.

#### Rejections under 35 U.S.C. §102

Claims 1-9, 11 and 12 were rejected under 35 U.S.C. § 102(b) as being anticipated by Haseloff *et al.* (WO 92/13090). Applicants respectfully submit that with the cancellation of these claims, this rejection is now moot. With respect to the new claims, Haseloff fails to describe the alteration of a deleterious molecule within a cell to a non-deleterious molecule. Rather Haseloff focuses on using the trans-splicing reaction to cause cell death, in particular by expressing molecules such as toxins. Thus, Applicants believe Haseloff is not relevant to the presently pending claims and, therefore, Applicants request that the rejection be withdrawn.

#### **Rejections under 35 U.S.C. § 103**

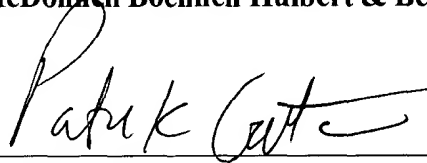
Cancelled claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Haseloff as applied to cancelled claims 1 – 9, 11 and 12 and further in view of Weber *et al.* (J. Gen. Virol. (1992) 73,2955-2961). Applicants respectfully submit that, with the cancellation of claim 10, this rejection is now moot. Accordingly, Applicants respectfully request that the rejection be withdrawn.

### **CONCLUSION**

With the above amendments and remarks, Applicants respectfully submit that the application is in condition for allowance. If Examiner is of the opinion that a telephone conference would expedite prosecution of the application, Examiner is encouraged to contact Applicants' undersigned representative.

Respectfully submitted,

**McDonnell Boehnen Hulbert & Berghoff**

A handwritten signature in black ink, appearing to read "Patrick Gattari", written over a horizontal line.

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